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SEP 14 2004

**OFFICE OF PETITIONS**

In re Application of :  
Krempl et al. : DECISION ON PETITIONS  
Application No. 09/887,469 : UNDER 37 CFR 1.78(a)(3) AND  
Filed: 22 June, 2001 : UNDER 37 CFR 1.78(a)(6)  
Atty Docket No. NIH-013/E-225-00/1 :

This is a decision on the twice renewed petition filed on 26 August, 2004, which is treated as a petition under 37 CFR 1.78(a)(3) and 1.78(a)(6), to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 119(e) for the benefit of the prior-filed provisional and nonprovisional applications as set forth in the concurrently-filed amendment.

The petitions are **GRANTED**

A petition for acceptance of a late claim for benefit under 37 CFR 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after 29 November, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii) and 1.78(a)(5)(ii). In addition, the petition under 37 CFR 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

(1) the reference required by 35 U.S.C. §§ 120 and 119(e) and 37 CFR 1.78(a)(2)(i) and 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;<sup>1</sup>

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<sup>1</sup> Any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed copending applications or international applications designating the United States of America must contain or be amended to contain a reference (amendment to the first line of the specification following the title or in an application data sheet (ADS) to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications. Cross references to other related applications may be made when appropriate. (see § 1.14).

(2) the surcharge set forth in § 1.17(t); and

(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant application was filed on 22 June, 2001, and was pending at the time of filing of the instant petition.

Additionally, the nonprovisional applications were filed within 12 months of the provisional applications to which priority under 35 U.S.C. § 119(e) is now being claimed. An amendment to insert a reference to the first sentence of the specification following the title, has been submitted as required by 37 CFR 1.78(a)(2)(iii) and 1.78(a)(5)(iii).

The instant nonprovisional application was filed after 29 November, 2000, and the claim for priority herein is submitted after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii) and 1.78(a)(5)(ii).<sup>2</sup> Accordingly, having found that the instant petition satisfies the conditions of 37 CFR 1.78(a)(3) and 1.78(a)(6) for acceptance of an unintentionally delayed claim for priority under 35 U.S.C. §§ 120 and 119(e), the petition to accept an unintentionally delayed claim of benefit to the prior-filed nonprovisional and provisional applications is granted.

The granting of the petition to accept the delayed benefit claim to the prior-filed application under 37 CFR 1.78(a)(3) and 1.78(a)(6) should not be construed as meaning that the instant application is entitled to the benefit of the filing date of the prior-filed applications. In order for the instant application to be entitled to the benefit of the prior-filed application, all other requirements under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (a)(2) and 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(4) and (a)(5) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed applications should **not** be construed as meaning that applicant is entitled to the claim for benefit of the prior-filed application noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether

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<sup>2</sup>See 35 U.S.C. § 120 and 119(e).

the instant application is entitled to the benefit of the earlier filing date.

It is noted that the amendment filed on 26 August, 2004, incorrectly states the filing date of Application No. 09/847,173 as 1 May, 2001. According to Office records, the filing date for this application is 3 May, 2001. While the correct filing date has been entered in the priority data, petitioners should submit a new preliminary amendment correcting the priority information.

A corrected Filing Receipt, which includes the priority claim to the prior-filed applications, accompanies this decision on petition.

Any questions concerning this matter may be directed to Senior Petitions Attorney Douglas I. Wood at 703-308-6918.

The application is being referred to Technology Center Art Unit 1648 for appropriate action on the amendment submitted on 26 August, 2004, including consideration by the examiner of the claim under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (a)(2) for the benefit of the prior-filed nonprovisional applications, and for consideration of the claim under 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(4) and (5) for the benefit of the prior-filed provisional applications.



Frances M. Hicks

Lead Petitions Examiner  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy

Encl: Corrected Filing Receipt